

APPLICATION N

09/628,23



DAVID T BRACKEN  
THE LAW OFFICE OF DAVID T BRACKEN  
4839 BOND AVENUE  
ORANGE CA 92869

**UNITED STATES DEPARTMENT OF COMMERCE**  
**Patent and Trademark Office**  
Address: COMMISSIONER OF PATENTS AND TRADEMARKS  
Washington, D.C. 20231

ATTORNEY DOCKET NO. **mk**

**0002.1G1**

EXAMINER

SORKIN, D

ART UNIT

PAPER NUMBER

**3**

**10/03/01**

Please find below and/or attached an Office communication concerning this application proceeding.

Commissioner of Patents and Trademarks

# Office Action Summary

Application No.

09/628,236

Applicant(s)

LITTLE ET AL.

Examiner

David L. Sorkin

Art Unit

1723

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☒ Responsive to communication(s) filed on 28 July 2000.
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

## Disposition of Claims

- 4) ☒ Claim(s) 1-17 is/are pending in the application.
- 4a) Of the above claim(s) 17 is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-16 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☒ Claim(s) 1-17 are subject to restriction and/or election requirement.

## Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 29 July 2001 is/are: a) ☐ accepted or b) ☒ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on \_\_\_\_\_ is: a) ☐ approved b) ☐ disapproved by the Examiner.  
If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

## Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).  
a) ☐ All b) ☐ Some \* c) ☐ None of:  
1. ☐ Certified copies of the priority documents have been received.  
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.  
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).  
\* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).  
a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

## Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s) 2.
- 4) ☐ Interview Summary (PTO-413) Paper No(s) \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other:

**DETAILED ACTION**

***Election/Restrictions***

1. Restriction to one of the following inventions is required under 35 U.S.C. 121:
  - I. Claims 1-16, drawn to a rubber mixer with rotatable shaft, classified in class 366, subclass 99.
  - II. Claim 17, drawn to a method of mixer, classified in class 366, subclass 348.

The inventions are distinct, each from the other because of the following reasons:

2. Inventions I and II are related as process and apparatus for its practice. The inventions are distinct if it can be shown that either: (1) the process as claimed can be practiced by another materially different apparatus or by hand, or (2) the apparatus as claimed can be used to practice another and materially different process. (MPEP § 806.05(e)). In this case the apparatus could be used at a speed of less than about 1500 rpm, with a material other than polymer particles, or for these then enough time to cause melting.
3. Because these inventions are distinct for the reasons given above and have acquired a separate status in the art as shown by their different classification, restriction for examination purposes as indicated is proper.
4. Because these inventions are distinct for the reasons given above and the search required for Group I is not required for Group II, restriction for examination purposes as indicated is proper.

Art Unit: 1723

5. During a telephone conversation with David Bracken on 26 September 2001 a provisional election was made without traverse to prosecute the invention of Group I, claims 1-16. Affirmation of this election must be made by applicant in replying to this Office action. Claim 17 is withdrawn from further consideration by the examiner, 37 CFR 1.142(b), as being drawn to a non-elected invention.

6. Applicant is reminded that upon the cancellation of claims to a non-elected invention, the inventorship must be amended in compliance with 37 CFR 1.48(b) if one or more of the currently named inventors is no longer an inventor of at least one claim remaining in the application. Any amendment of inventorship must be accompanied by a petition under 37 CFR 1.48(b) and by the fee required under 37 CFR 1.17(i).

#### ***Drawings***

7. The drawings (particularly figs. 2 and 3) are objected to as failing to comply with 37 CFR 1.84(p)(1). "Reference characters ... must not be ... enclosed with outlines, e.g. encircled". Correction is required.

8. The drawings (particularly figs. 2 and 3) are objected to as failing to comply with 37 CFR 1.84(p)(3). "Numbers, letters, and reference characters must measure at least .32 cm. (1/8 inch) in height." Correction is required.

9. The drawings are objected to as failing to comply with 37 CFR 1.84(p)(4) because the reference character has been used to designate different parts. Examples include 1, 3,4,5,6,7 and 8. Correction is required.

Art Unit: 1723

10. The drawings are objected to as failing to comply with 37 CFR 1.84(p)(5) because they include the following reference signs not mentioned in the description:

19,20,21,22,23,24,25,26,27,30,31,32,33,34,35,36, and 37. Correction is required.

11. The drawings are objected to as failing to comply with 37 CFR 1.84(h)(3). The sectional lines Fig. 4 are not proper. "The ends of the broken line should be designated by Arabic or Roman numerals corresponding to the view number of the sectional view..." Therefor A—A should be V – V or 5 – 5, B – B should be VI – VI or 6 – 6, etc. Correction is required.

12. The drawings are objected to as failing to comply with 37 CFR 1.84(r). Arrow may only be used in particular circumstances. Applicant has used an arrow for almost every reference character. Arrow may only be used according to 1.84(r). Correction is required.

### ***Specification***

13. The disclosure is objected to because of the following informalities: The references in the specification to section lines A -- A to E – E must be changed consistent with the drawing corrections discussed above.

Appropriate correction is required.

### ***Claim Rejections - 35 USC § 112***

14. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Art Unit: 1723

15. Claims 1-16 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

16. In claims 4, 5, 14 and 15 it is unclear which of the plurality of shaft extensions "the shaft extension" refers to.

17. In claims 1, 6, 9, 10, 14 and 16 it is unclear what is meant by "the inside surface"; "the inside surface" of what?

***Claim Rejections - 35 USC § 102***

18. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(a) the invention was known or used by others in this country, or patented or described in a printed publication in this or a foreign country, before the invention thereof by the applicant for a patent.

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

(e) the invention was described in a patent granted on an application for patent by another filed in the United States before the invention thereof by the applicant for patent, or on an international application by another who has fulfilled the requirements of paragraphs (1), (2), and (4) of section 371(c) of this title before the invention thereof by the applicant for patent.

19. Claims 1-10 and 13-16 are rejected under 35 U.S.C. 102(b) as being anticipated by Sutter (US 3,591,146). Regarding claim 1, Sutter ('146) discloses a mixer comprising a substantially cylindrical mixing chamber (4) with an inside enclosing a rotatable shaft (14); and shaft extensions (16,16',17) removable from the shaft. Regarding the stipulations of intended use recited in claim 1 and other claims, "apparatus claims cover what a device *is*, not what a device *does*" ((emphasis in original) *Hewlett-Packard C. v. Bausch & Lomb Inc.*, 909 F.2d 1464, 1469, 15 USPQ2d

Art Unit: 1723

1525, 1528 (Fed. Cir. 1990)). Apparatus must be structurally distinguishable from the prior art. See MPEP 2114 for more information. Regarding claim 2, the shaft extensions comprise a base (17) and an end portion (16), the end portion being removable from the base portion and the base being removable from the shaft.

Regarding claim 3, the end portion comprises a tooth face comprising a major face, the major face being substantially flat and orient such that when passing through a plane including the shaft axis the major face first encounters the plane with a leading edge of the major face and the major face extends along an acute angle therefrom away from the plane (see drawing). Regarding claim 4, the leading edge comprises most of a height of the shaft extension (see drawing). Regarding claim 5, the shaft extension rises from the shaft to very close to the inside surface (see drawing). Regarding claim 6, the base portion is secured to the shaft by key and slot means (see drawing).

Regarding claim 7, the end portion comprises a substantially complete shield (16").

Regarding claim 8, the tooth face further comprises a lower bevel face extending away from the plane from a lower edge of the major face at a greater angle to the plane than the major face (see drawing). Regarding claim 9, the tooth face further comprises a top face extending away from a top edge of the major face and adapted to drive the particles into the inside surface (see drawing). Regarding claim 10, Sutter ('146) discloses a mixer comprising a substantially cylindrical mixing chamber (4) with an inside enclosing a rotatable shaft (14); and shaft extensions (16,16',17) comprising a tooth face, the tooth face comprising a major face, the major face being substantially flat and orient such that when passing through a plane including the shaft axis the major

Art Unit: 1723

face first encounters the plane with a leading edge of the major face and the major face extends along an acute angle therefrom away from the plane (see drawing). Regarding claim 13, the leading edge comprises most of a height of the shaft extension (see drawing). Regarding claim 14, the shaft extension rises from the shaft to very close to the inside surface (see drawing). Regarding claim 15, the tooth face further comprises a lower bevel face extending away from the plane from a lower edge of the major face at a greater angle to the plane than the major face (see drawing). Regarding claim 16, the tooth face further comprises a top face extending away from a top edge of the major face and adapted to drive the particles into the inside surface (see drawing).

20. Claims 10-16 are rejected under 35 U.S.C. 102(a and e) as being anticipated by White et al. (US 6,022,137). Regarding claim 10, White ('137) discloses a mixer comprising a substantially cylindrical mixing chamber (54) with an inside enclosing a rotatable shaft (76); and shaft extensions (78,78) comprising a tooth face, the tooth face comprising a major face, the major face being substantially flat and orient such that when passing through a plane including the shaft axis the major face first encounters the plane with a leading edge of the major face and the major face extends along an acute angle therefrom away from the plane (figs. 1 and 2). Regarding claim 11, the shaft supports at least two rows 180 degrees apart of shaft extensions along the length of the shaft (see fig. 2). Regarding claim 12, the shaft supports at least two rows 180 degrees apart of shaft extensions along the length of the shaft (see fig. 2). Regarding claim 13, the leading edge comprises most of a height of the shaft extension (see drawing). Regarding claim 14, the shaft extension rises from the shaft to very close to



Art Unit: 1723

the inside surface (see fig. 1g). Regarding claim 15, the tooth face further comprises a lower bevel face extending away from the plane from a lower edge of the major face at a greater angle to the plane than the major face (see fig. 2). Regarding claim 16, the tooth face further comprises a top face extending away from a top edge of the major face and adapted to drive the particles into the inside surface (see figs. 1 and 2).

Any inquiry concerning this communication or earlier communications from the examiner should be directed to David L. Sorkin whose telephone number is 703-308-1121. The examiner can normally be reached on 7:30 - 5:00 Mon.-Thur., Alternate Fridays.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Wanda L. Walker can be reached on 703-308-0457. The fax phone numbers for the organization where this application or proceeding is assigned are 703-872-9310 for regular communications and 703-872-9311 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-308-0661.



David Sorkin

October 1, 2001



**CHARLES E. COOLEY  
PRIMARY EXAMINER**